

## REMARKS

### Summary

Claims 13-26 were pending and all of the claims were rejected in the present Office action. The Applicant has carefully considered the reference and the arguments presented by the Examiner, and respectfully submits that a *prima facie* case of anticipation has not been made out. Claim 13 is amended to correct a grammatical error. Claim 22 is amended solely to correct an omission of the claim number in a previous amendment. The Applicant respectfully submits that this amendment is purely administrative, as the numbering would have been obvious on inspection of the pattern of numbering changes.

The Applicant respectfully traverses the finality of the Office action. The Examiner states (Office action, Item 17), that making the Office action final was necessitated by "[a]pplicant's amendment". The Applicant respectfully submits that the amendments made were purely administrative, and served to implement the Examiner's requirement set forth in Item 5 of the Office action of March 9, 2007. The Applicant acknowledges that, at Item 4 of the present Office action, the Examiner stated that the Applicant's arguments were not persuasive. However, the Examiner has seen the need to further clarify the record by elaborating on the reasons for rejection. As such, the Applicant believes that it is appropriate for the Examiner to withdraw the finality of the Office action as premature, as it was not necessitated by the formal reasons stated by the Examiner.

The USPTO has made substantial changes to the rules regarding patent prosecution, and the Applicant believes that the benefit afforded by filing a Request for Continuing Examination (RCE) prior to November 1, 2007, which is the effective date of the new regulations, will provide a better opportunity to properly prosecute the application. This does however require the Applicant to forgo the opportunity to file a response after final office action, and to have the benefit of the Examiner's response.

Similarly, as the Examiner as cited the formal amendments as prompting the finality of the present Office action, the Applicant respectfully submits that there is no justification for the Examiner to consider a "first action final" response to this submission as an RCE. Since there must have been some aspect the claim amendments that the

Examiner depended upon to make the present Office action final, this should be clarified in the next Office action.

Should the Examiner not allow the pending claims in the next Office action, and the action is to be non-final, the Applicant requests a telephonic interview at a mutually convenient time. Should the Examiner intend to make the first Office action on the RCE a final Office action for any reason, the Applicant requests a telephonic interview at a mutually convenient time prior to the issuance of the Office action. From PTOL-413A is appended hereto.

### **Claim Objections**

The Examiner continues to object to Claim 13 on the basis that the phrase "adapted to" is used, "without providing what the adaptation is that has been performed on the compensation device." The Examiner suggests that the phrase "configured to" be used as the Examiner considers the component to be unmodified.

The Applicant respectfully traverses this objection and respectfully requests that the objection be withdrawn as not being in accordance with any rule or practice. The Applicant is entitled to use appropriate words, which are not misleading, to describe the invention as claimed. The Applicant does not accept that the Examiner's characterization of the words "adapted to" or the words "configured to" is definitive. The meaning of the words "adapted to" will be apparent to a person of ordinary skill in the art when reading the specification of the application and the claim.

Both phrases are terms of art in patent drafting. For a discussion of "adapted to" see MPEP §2111.04, and for the usage of "configured to", see the context of MPEP §2106. Since the phrase "configured to" is discussed in the context of computer-implemented inventions, the Applicant respectfully submits that the present choice of wording would be more appropriate and respectfully requests that the objection be withdrawn. The Applicant notes that the present invention is capable of being implemented by a variety of electronic techniques, which may, but not necessarily, involve a computer.

## **Claim Rejections**

### **35 U.S.C. § 102(b)**

Claims 13-26 were rejected under 35 U.S.C. § 102(b) as being anticipated by Lenz (US 6,448,755; "Lenz"). The Applicant respectfully traverses this rejection on the basis that a *prima facie* case of anticipation has not been made out.

Claim 13 recites, *inter alia*, a compensation device adapted to connect to the electrical energy source and to measure a first parameter value.

The Examiner has clarified the identification of the various circuit elements of the reference used in making the rejection. The Applicant interprets the Examiner's identifications as follows:

Amplifier Output Stage	6
Control loop components	1 and 7 (including all of the components of FIG. 2)
Modulator	4
Control Device	4 and 15
Output control signal	5
Regulator signal (RS)	5
Reference value	2 (providing electrical an electrical current and polarity; an electrical current source)
First parameter value	3 (an input supply voltage)
Second parameter value	(reference value of an amplifier voltage or a reference value of the load current)
Regulation system	4, 15, and 10-22 (15 and 10-22 are the equivalent of 1) or (4 and 1)
Regulator signal	5
Energy source	3 (a voltage source)
Compensation signal	-----
Compensation device	1
Adjustable amplifier	20 (preferably adjusted so that there is no amplification in component 9; col. 4 lines 1-5)

The Applicant accepts that the Examiner may combine the functions of several of the modules taught by the reference, but respectfully submits that the functions thereof may not be changed.

When making a rejection under 35 U.S.C. § 102, all of the elements of the claim must be found in the same reference, and the elements must be arranged as set forth in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir 1984) (citing *Connell v. Sears Roebuck & Co.* 722 F.2d 1542 220 USPQ 193 (Fed. Cir. 1983)). Further, the use of two terms to refer to the same thing is ambiguous, and an ambiguous reference cannot be used in making an anticipation rejection. (*In re Turley*, 304 F.2d 893, 899 134 USPQ 355, 360(CCPA 1962)).

The Examiner asserts that "a regulation system [4 and 1] is connected on the input side to the output stage [6]." (Office action, page 4 lines 2-5). This sentence may be interpreted as meaning that a) the input of the regulation system is connected to the output stage, or b) the regulation system is connected to the input side of the output stage. From Fig. 1, it can be seen that the input side of the regulation system (as defined by the Examiner) is connected to a reference value [2] and a first parameter value [3], and not to the input of the output stage.

FIG. 1 also identifies [3] as the actual value and [7] as the actual value detector. The actual value [3] is proportional to the current flowing in coil [8]. The examiner asserts that the components 1 and 7 are "configured to connect to the electrical energy source [3]....and to measure a first parameter value [3] (i.e., an actual value of an output supply voltage)." (Office action page 3, Item 3, lines 12-15).

However Lenz teaches that the actual value detector 7, measures the load current through an inductive load 8 having resistive losses. (Lenz, col. 2, lines 17-19). The relationship between voltage and current in an AC electronic circuit having transients is not a simple proportionality constant, and there is nothing to suggest that the measurement of the current in the load is proportional to the voltage output as in a resistive circuit. Therefore, nothing in Lenz teaches measuring the output voltage as asserted by the Examiner.

Nothing in Lenz teaches that an output supply voltage is measured. For purposes of this response only, the Applicant believes the Examiner is referring to a voltage that appears between the two terminals of element 7 marked on FIG. 1 by "o".

The Examiner also asserts that regulation system [4 and 1] is connected on the output side to the control device [4 and 15] and configured to produce a regulator signal (RS) [5].....(i.e., resulting output signal 5)". (Office action, page 4, lines 4-8). FIG. 1 of Lenz shows that the output of element 4 (Lenz's modulator) connects to the output stage [6] and that the regulator signal (RS) [5] connects between element [15] as shown in FIG. 2 and element [4]. (Office action, Item 4). The regulation signal (RS) [5] is shown by Lenz to connect between element [15] and element [4] and is therefore not an output signal of the control device [4 and 15]. Therefore, the Examiner has not unambiguously described the arrangement of FIG. 1. An ambiguous reference cannot be used in making an anticipation rejection. (*In re Turley*, 304 F.2d 893, 899 134 USPQ 355, 360(CCPA 1962)).

The Examiner also asserts that "the supplied voltages taught throughout the reference that "the energy source" whose actual input value is component 3 is a voltage source, and the first parameter [3] is an input supply voltage." (Office action, page 4, Item 9). To the contrary, Lenz teaches that [3] is an actual value of a pulsed signal (see FIG. 3b), which has been identified above as proportional to a measurement of the current (not the energy supply or output voltage) in the load 8. As such, this would not be the "electrical energy source" that the Examiner describes as connecting to the output stage 6 at the "o" locations. The characteristics of this source are suggested as having a positive value (+) of the voltage on the upper of the two "o" locations and a negative value (-) on the lower of the two "o" locations.

If the "electrical energy source" is connected to the amplifier output stage 6, the compensation device 1 does not connect to the electrical energy source.

With these points in mind, the Applicant respectfully submits that the aspect of Claim 13, where a compensation device is adapted to connect to the electrical energy source and to measure a first parameter value is not shown in the reference.

For at least these reasons, the reference does not teach all of the elements and limitations of Claim 13 and the arrangement thereof, and a *prima facie* case of

anticipation has not been made out. Claims 14-19, being claims dependent on an allowable claim are allowable, without more.

Claim 20 recites the allowable subject matter of claim 13, and is therefore allowable for at least the same reasons.

Claim 21 is a method claim and is allowable for at least the same reasons as Claim 13. Claims 22-26 are claims dependent on an allowable claim and are allowable, without more.

In the Office action, at Item 11, last line, the Examiner makes reference to substantially all of the disclosure of the specification of the reference ("see figures 1 and 2, col. 1 line 38 through col. 4 line 19") in supporting the rejection of Claim 17. Since no point cites are provided, the Applicant is unable to identify the specific nature of the teaching that has been applied. The Applicant respectfully submits that, should the present traverse not be accepted, the next Office action should be non-final so that a proper response may be made. This request has been previously made, and the Applicant respectfully requests a specific response.

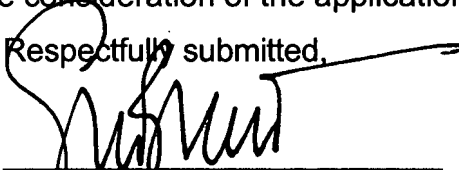
### **Conclusion**

Claims 13-26 are pending.

For at least the reasons given above, the Applicant respectfully submits that the pending claims are allowable and looks forward to the early issuance of a Notice of Allowance.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,

  
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